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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/781,059

02/17/2004

Spyridon Artavanis-Tsakonas

7326-132

8386

20583

7590

03/26/2008

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EXAMINER

STOICA, ELLY GERALD

ART UNIT

PAPER NUMBER

1647

MAIL DATE

DELIVERY MODE

03/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/781,059	Applicant(s) ARTAVANIS-TSAKONAS ET AL.	
	Examiner ELLY-GERALD STOICA	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-67, 86 and 88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 59-67 and 88 is/are allowed.
- 6) ☒ Claim(s) 86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/29/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. In response to the non-final rejection Office action, filed on 11/29/2007, Applicant cancelled claims 1-58, 68-85, 87, and 89-92 and amended claims 65-66, 86 and 88. Claims 59-67, 86 and 88 are pending and currently examined.

Priority

2. As iterated in the previous Office action, The disclosure of the prior-filed application, Application No. 08/899,232, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claim 86. Claim 86 contains subject matter that was not disclosed in the Application No. 08/899, 232. The subject matter was disclosed in a later-filed application, No. 09/121457 and therefore the priority date for this particular subject matter is the filing date of 07/23/1998.

3. On pages 4-5 of their remarks, Applicants argue that the specific linkage recited in the claim 86 is an inherent characteristic of the Notch heterodimer and is sufficiently identified in the Application No. 08/899, 232.

The arguments were carefully considered but not found persuasive because the reducing-agent sensitive linkage between N^{EC} and NTM of the heterodimeric Notch does not suggest or describe the metal ion-dependent sensitive linkage claimed in claim 86 of the Application No. 09/121457 (and the instant Application), as the description of the

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genus cannot anticipate a specie. Therefore, the claim 86 is given the priority of 07/23/1998.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 86 remains rejected under 35 U.S.C. 102(e) as being anticipated by Rubin et al. (U.S. Pat. 5,935,792, 08/10/1999) for the reasons of record.

On page 6 of their Remarks, Applicants argue that the Rubin et al. rejection is not available as a 35 U.S.C. 102(e) reference since the priority given to the enabling provisional Application 60/053,476 is the 7/23/1997. The arguments were carefully considered but not found persuasive with regard to claim 86 because the priority date for the claim 86 is 07/23/1998.

Conclusion

6. Claim 86 is not allowed. Claims 59-67 and 88 are allowable over the prior art. However the claims are essentially described in the Rubin et al. (U.S. Pat. 5,935,792, 08/10/1999) and, at such time as all pending claims are in condition for allowance, the Application will be referred to an Interference specialist in the Office for determination as

to whether an interference proceedings would be appropriate. Applicant is advised of the right to suggest an Interference according to 37 CFR 41.202.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELLY-GERALD STOICA whose telephone number is (571)272-9941. The examiner can normally be reached on 8:30-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath N. Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorraine Spector/ Ph.D.
Primary Examiner, Art Unit 1647